REMARKS

This is a response to the Office Action mailed April 6, 2004. Claims 12-16 and 19-60 are pending in the application. Claims 12-16 and 19-21 have been rejected by the Examiner. As noted above, Applicants have amended Claims 12 and 19, and added Claims 22-60. The amendments and new claims are fully supported by the written description. Also, no new matter has been introduced into the application.

Claim Rejections - 35 U.S.C. § 112

The Examiner has rejected Claims 12, 15, 16, 19 and 20 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. In particular, it is the Examiner's position that the "specification is clear that the delivery of either the permeabilizing agent or drug is accomplished by either a stent or catheter. (see page 3, lines 12-13). No other devices have been enabled."

According to Section 2164.01 of the Manual of Patent Examining Procedure (MPEP), the enablement requirement obliges that "the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation." MPEP, Section 2164.01 at 2100-178 (8th Edition, *rev.* Feb. 1, 2003) (citing *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988)). According to Section 2164.04 of the MPEP, "[i]n order to make a rejection, **the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention**." MPEP, Section 2164.04 at 2100-183 (citing *In re Wright*, 999 F.2d 1557, 1562 (Fed. Cir. 1993)) (emphasis added). Furthermore,

> [a] specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support.

Id. (citing *In re Marzocchi*, 439 F.2d 220, 224 (CCPA 1971)).

Applicants respectfully submit that the Examiner has failed to meet the initial burden of establishing a reasonable basis to question the enablement provided for the claimed invention. As noted above, the Examiner concluded that the specification only describes delivery of the permeabilizing reagent or the drug "by either a stent or catheter" and that "[n]o other devices have been enabled." The enablement requirement does not oblige an applicant to mention each and every device that could be used to deliver the agents in order to enable the invention. Rather, the "test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art **without undue experimentation**." *United States v. Telectronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988).

By referring to the disclosure of the current specification coupled with information known in the art, one reasonably skilled in the art could certainly make or use the invention as claimed by Claims 12, 15, 16, 19 and 20 without undue experimentation. Claim 12, as amended, reads,

> A method of delivering a drug through a membrane junction or a cell membrane comprising:
> delivering a permeabilizing reagent to a membrane junction or a cell membrane in a concentration sufficient to increase the permeability of the membrane junction or cell membrane; and
> delivering a drug to the membrane junction or cell membrane, wherein the drug travels through the membrane junction or cell membrane.

Moreover, Claim 19 as amended reads:

> A method of local drug delivery, comprising:
> locally applying a permeabilizing reagent to a selected area of a body tissue; and
> locally applying a drug to the body tissue.

The disclosure unquestionably teaches one having reasonable skill in the art how to deliver the

agents to selected sites within the body.

The specification broadly teaches that the agents can be applied to a selected site by various methods based on different means of agent delivery. First, the specification broadly teaches that the agents can be delivered to the selected site systemically. See page 21, lines 9-14. One of ordinary skill in the art would certainly understand how to systemically deliver the agents of the present invention, such as by injection or use of excipients. Second, the specification also broadly teaches that the agents can be delivered to a local site. For example, the specification broadly teaches that the agent can be locally delivered by means of diffusion from an agent source. In particular examples, the specification teaches that the agents can be delivered to the selected site by: (1) diffusion through a permeable membrane (e.g., the balloon catheter described on pages 18-20); (2) diffusion through means of mechanical pressure (e.g., through the drug infusion catheter described on pages 20-21); and (3) diffusion from a polymeric matrix (e.g., from the polymeric coating described on pages 21-23).

Furthermore, the specification clearly teaches that the agents can be delivered by a variety of devices, not just catheters and stents. For example, on page 18, it is noted that "the permeabilizing reagent may be delivered to the target tissue by a variety of devices, including, **but not limited to**, balloon catheters, drug infusion catheters, and stents." Also, on page 21, the specification states, "[o]f course, the balloon catheter design and drug infusion catheter designs discussed above are merely exemplary; other catheter designs, **and indeed other local delivery devices**, may be used in accordance with the invention."

It is submitted that the Examiner has failed to meet the initial burden of establishing a reasonable basis to question the enablement. The Examiner has improperly focused on the different devices mentioned in the specification rather than reviewing the broad teachings

apparent in the description of how to make and use the inventive concepts. The Examiner should instead consider the broad teachings of the specification regarding the mechanisms and means that can be used to deliver the agents to the selected site for treatment. Also, Applicants submit that the skill level of those of ordinary skill in the relevant field is relatively high. Upon examination of the specification as a whole, one of ordinary skill in the art would no doubt be able to practice the invention as claimed in Claims 12 and 19 **without undue experimentation**. In short, Applicants respectfully request the Examiner to reconsider and remove the Section 112 rejection.

Claim Rejections - 35 U.S.C. § 103

The Examiner has rejected Claims 12, 13, 14, 16, 19, 20 and 21 under 35 U.S.C. Section 103(a) as being unpatentable over Walsh et al. (U.S. Patent Number 6,689,807). The Walsh et al. patent was filed on June 8, 2000. As can be seen from the attached unexecuted[1] Declaration Under 37 CFR 1.131, the subject matter for at least Claims 12 and 19 was invented prior to the filing date of the Walsh et al. patent. Therefore, the Walsh et al. patent is not available as prior art under 35 U.S.C. Section 102(e), and Applicants have successfully traversed the rejection of Claims 12, 13, 14, 16, 19, 20 and 21 as being obvious over Walsh et al. Applicants respectfully request the Examiner to remove this rejection.

[1] An executed copy of the Declaration will be filed in due course, and no later than a request for the same by the Examiner.

CONCLUSION

Claims 12-16 and 19-60 are pending in this application. Applicants submit that the claims are in condition for allowance. Applicants respectfully request the Examiner to enter the foregoing amendments and pass the case to issue.

If the Examiner has any questions or concerns, the Examiner is invited to telephone the undersigned attorney at (415) 954-0345.

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Respectfully submitted,

Squire, Sanders & Dempsey LLP
One Maritime Plaza, Suite 300
San Francisco, CA 94111-3492
Telephone: 415-954-0345

Paul J. Meyer, Jr.
Reg. No. 47,791
Attorney for Applicants